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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/596,110	06/16/2000	Kazumoto Kondo	450100-02572	2719
20999	7590	11/19/2003		
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151				
			EXAMINER SMITH, PETER J	
			ART UNIT 2176	PAPER NUMBER 7

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/596,110

Applicant(s)

KONDO, KAZUMOTO

Examiner

Peter J Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: application filed on 06/16/2000.
2. Claims 1-6 are pending in the case. Claims 1 and 4 are independent claims.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 1, 3-4, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Huffman et al. (hereafter referred to as Huffman), US 5,663,748 issued 09/02/1997.**

Regarding independent claim 1, Huffman discloses a display means for displaying multiple elements forming contents of book in fig. 1-7, and col. 3 line 64 – col. 4 line 3. Huffman discloses a display control means for determining the type of mark to emphasize the specified element according to the position specified in the area displaying the specified element when an optional element is specified from among said multiple elements via input means and for attaching said determined mark to said specified element in fig. 19, 23, 27, and col. 17 line 62 – col. 18 line 24.

Regarding dependent claim 3, Huffman discloses changing the display condition of a mark displayed on a specified element according to the specified operational procedure via an input means in fig. 19, 23, 27 and col. 17 line 62 – col. 18 line 24.

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Regarding independent claim 4, Huffman discloses displaying multiple elements comprising contents of a book on the display means in fig. 1-7, and col. 3 line 64 – col. 4 line 3. Huffman discloses when an optional element is specified from among multiple elements to be displayed on a display means via the input means, determining the type of mark to emphasize the specified element according to the position specified in the area displaying the specified element and attaching a determined mark onto the specified element in fig. 19, 23, 27, and col. 17 line 62 – col. 18 line 24.

Regarding dependent claim 6, Huffman discloses changing the display condition of a mark displayed on a specified element according to the specified operation procedure via an input means in fig. 19, 23, 27 and col. 17 line 62 – col. 18 line 24.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 2 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huffman et al. (hereafter referred to as Huffman), US 5,663,748 issued 09/02/1997 in view of Hasting et al. (hereafter referred to as Hastings), US 5,885,012 issued 03/23/1999.**

Regarding dependent claim 2, Huffman does not teach a display control means which changes the display condition of a mark according to the number of times the specified element

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is specified. Hasting does teach does teach a display control means which changes the display condition of a mark according to the number of times the specified element is specified in col. 10 lines 26-42. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Hastings into Huffman to have created the claimed invention.

It would have been obvious and desirable to incorporate a means for creating different versions of the same mark such as a varying underline thickness. This would have allowed the user to have more significantly marked the most important passages and less significantly marked passages of modest importance. This would have helped the user of the electronic book to have better organized the text contained in their electronic book.

Regarding dependent claim 5, Huffman does not teach changing the display condition of a mark according to the number of times the specified element is specified. Hastings does teach changing the display condition of a mark according to the number of times the specified element is specified in col. 10 lines 26-42. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Hastings into Huffman to have created the claimed invention.

It would have been obvious and desirable to incorporate a means for creating different versions of the same mark such as a varying underline thickness. This would have allowed the user to have more significantly marked the most important passages and less significantly marked passages of modest importance. This would have helped the user of the electronic book to have better organized the text contained in their electronic book.

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Conclusion


7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sach et al., US 5,331,865 B1 filed 10/16/1998 discloses a method and system for electronically distributing digital contents. The digital contents include textual, graphical, and pictorial information. Yamazaki et al., US 5,475,398 issued 12/12/1995 discloses an electronic device, such as an electronic book, which retrieves information from a memory and displays the information. A matrix array of sensors associated with the display can be actuated by a user to designate particular portions of a displayed page and in response to the designations, flags are stored identifying the designated portions, and the appearance of the portions on the display is modified to visually highlight the portions. Tsuchiya, US 5,239,665 issued 08/24/1993 discloses an electronic book which allows the user to underline certain portions of text.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J Smith whose telephone number is 703-305-5931. The examiner can normally be reached on Mondays-Fridays 7:00am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on 703-305-9792. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

PJS


JOSEPH H. FEILD
PRIMARY EXAMINER